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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,975	07/25/2001	Suellen Kae Birkholz	ROC920010108US1	6558
7590 01/21/2005			EXAMINER	
Gero G. McClellan Thomason, Moser & Patterson, L.L.P. Suite 1500 3040 Post Oak Boulevard Houston, TX 77056-6582			NGUYEN BA, HOANG VU A	
			ART UNIT	PAPER NUMBER
			2122	
DATE MAILED: 01/21/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/912,975	Applicant(s) BIRKHOLZ ET AL.	
	Examiner Hoang-Vu A Nguyen-Ba	Art Unit 2122	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the amendment filed September 10, 2004.
2. Claims 1-27 are pending.

Response to Amendments

3. The objection to claims 2-3 and 18-20 is withdrawn in view of Applicants' amendments to these claims to correct some minor informalities.
4. The rejection of claims 18, 19 and 20 under 35 U.S.C. § 112, second paragraph is withdrawn in view of Applicants' amendments to these claims to correct some identified terms lacking proper antecedent basis.

Response to Arguments

5. Applicant's arguments filed September 10, 2004 have been fully considered but they are not persuasive. Following is the Examiner's response to Applicants' arguments.

Claims 1, 14 and 17

Applicants' arguments:

Fawcett does not teach verifying one or more business contracts for a software inventory. Respectfully, the Examiner mistakenly argues that Figure 4A, step 72 teaches the claimed step of verifying. In fact, step 72, and Figure 4A generally, confirm that no verification of business contracts is taught. Step 72 comparing the collected user inventory data to entries in a database containing information about available computer software. In this regard, Applicants make a number of observations. First, the Examiner relates the claimed "software inventory from the customer system" to *Fawcett*'s inventory data from the user computer" (col. 7, lines 26-29; step 70). This same inventory data of *Fawcett* is what is compared to entries in the database containing information about available computer software at step 72 of

Figure 4A (col. 7, lines 29-33). Accordingly, the cited portions of Figure 4A (steps 70 and 72) teach only inventory data and a database containing information about available computer software. No business contracts are taught and no verification of one or more business contracts for software inventory is taught.

Examiner's response:

The Examiner notes that the U.S. Court of Customs and Patent Appeals has held that claims are to be given their broadest reasonable interpretation during the prosecution of a patent application. In re Pearson 494 F.2d 1399, 1403, 181 USPQ 641, (CCPA 11974). In this instance, the Examiner interprets the term “business contract,” considered in the context of Fawcett teachings taken as a whole, to mean a binding agreement between a user and an software update service whereby the user agrees to pay the update service for the purchase and update of available computer software (see at least 2:24 – 3:3:13). According to Fawcett teachings, the payment information is verified before any inventories of the computer software available on the user's computer and transfers are made. In light of this interpretation, the Examiner considers the limitation “verifying one or more business contracts for a software inventory” to read on Fawcett and the rejection of claims 1, 14 and 17 under 35 U.S.C. § 102(b) as being anticipated by Fawcett to be proper and thus maintained.

Claims 7 and 21

Applicants' arguments:

For example, claims 7 and 21 recite that verifying that one or more business contracts comprises validating a subscription to software. The Examiner cites col. 2, lines 61 through Col. 3, line 2. However, Applicants point out that the cited portion

is directed to payment of software, not a subscription to software. No mention of a subscription to software is made. In fact, this cited portion of *Fawcett* is more appropriately characterized as teaching a non-subscription, pay-as-you-go system and, hence, teaches away from a subscription service to software.

Examiner's response:

The portion of *Fawcett* cited by the Examiner should be construed in the context of *Fawcett* teachings taken as a whole. *Fawcett* teaches that after the user agrees to purchase a computer software, the user is entitled, among other things, to be alerted to any new updated version of the purchased computer software (3:14-42). This feature is in a way a subscription to software.

Accordingly, the rejection of claims 7 and 21 under 35 U.S.C. § 102(b) as being anticipated by *Fawcett* is considered to be proper and maintained.

Claims 8 and 22

Applicants' arguments:

Claims 8 and 22 recite verifying entitlement for one or more keyed software in a software inventory. The Examiner cites Col. 2, line 58 through Col. 3, line 58 which refers to a secure connection. More specifically, the cited portion teaches that the connection over which payment information is transferred can be made secure to protect the user's account information (e.g., credit card number). Thus, the cited portion does not teach verifying entitlement for one or more keyed software in a software inventory.

Examiner's response:

Taken in the context of Fawcett teachings, when a user accesses the remote update service, an update service computer conducts an automatic inventory of the computer software on the user computer. The data collected from the inventory of the user computer software on the user computer is then used to make comparisons to database entries from a database on the update service computer. The computer software available on the update service computer is downloaded to the user computer using encryption scheme which means that the computer software is keyed.

Claims 12, 13 and 26

Applicants' arguments:

Applicants traverse the rejection. *Fawcett* is believed to have been overcome with respect to base and intervening claims 1, 10 and 17, 24, respectively, for the reasons given above. Accordingly, the combination rejection is believed to have been overcome.

Examiner's response:

Since the rejection of the base and intervening claims is maintained for the reasons discussed above, the rejection of claims 12, 13 and 26 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Fawcett and Hellerstein et al. is also maintained.

According to the foregoing discussion, the rejection of claims 1-11 and 14-26 under 35 U.S.C. § 102(b) as being anticipated by Fawcett and of claims 12, 13 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Fawcett in view of Hellerstein are considered to be still proper and maintained.

Claim Rejections – 35 U.S.C. § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-11 and 14-26 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,845,077 to Fawcett.

Claims 1, 14 and 17

Fawcett disclose at least:

receiving, by a supplier system, a software inventory from the customer system (see at least Figure 4A, step 70 and related discussion in the specification);

verifying one or more business contracts for the software inventory utilizing one or more databases connected to the supplier system (see at least Figure 4A, step 72 and related discussion in the specification);

determining one or more software upgrade releases for the software inventory utilizing a product topology database connected to the supplier system (see at least Figure 4A, steps 74, 76, 78, 80, 82 and related discussion in the specification).

Claim 27

Since claim 27 recites similar features of claim 1, the same rejection is thus applied.

Claims 2 and 18

The rejection of base claim 1 is incorporated. Fawcett further discloses *displaying the one or more software upgrade releases for customer approval* (see at least Figure 4B, step 82 and related discussion in the specification).

Claims 3 and 19

The rejection of base claims 1 and 17 and intervening claims 2 and 18, respectively is incorporated. Fawcett further discloses *forwarding an approved order to a fulfillment and distribution center* (see at least Figure 4B, steps 86, 88, 90, 92 and related discussion in the specification).

Claims 4 and 20

The rejection of base claims 1 and 17 and intervening claims 2 and 18, respectively is incorporated. Fawcett further discloses *prompting one or more responses from a customer utilizing graphical user interfaces* (see at least Figure 4B, steps 90, 92 and related discussion in the specification).

Claim 5

The rejection of base claim 1 is incorporated. Fawcett further discloses *wherein the software inventory is received after a software upgrade request* (see at least Figure 4A, step 68, 70 and related discussion in the specification).

Claim 6

The rejection of base claim 1 is incorporated. Fawcett further discloses *wherein the software inventory is received periodically* (see at least Abstract, lines 3-4 and related discussion elsewhere in the specification).

Claims 7 and 21

The rejection of base claims 1 and 17 is incorporated. Fawcett further discloses *wherein verifying one or more business contracts comprises validating subscription for one or more subscription software in the software inventory utilizing a subscription entitlement database* (see at least 2:61 – 3:2).

Claims 8 and 23

The rejection of base claims 1 and 17 is incorporated. Fawcett further discloses *wherein verifying one or more business contracts comprises verifying entitlement for one or more keyed software in the software inventory utilizing a keyed management system database* (see at least 2:58 – 3:2, e.g., “encryption scheme,” “secure transaction technology,” “digital signature”).

Claims 9 and 23

The rejection of base claims 1 and 17 is incorporated. Fawcett further discloses *wherein determining one or more software upgrade releases comprises mapping software releases in the software inventory to software upgrade releases* (see at least 2:30 – 45).

Claims 10 and 24

The rejection of base claims 1 and 17 is incorporated. Fawcett further discloses *wherein determining one or more software upgrade releases comprises: filtering the software inventory; categorizing the software inventory; mapping software releases in the software inventory, to software upgrade releases; categorize software upgrade releases; and generate an upgrade order* (see at least Figure 4A, steps 72, 74, 76; Figure 4B, steps 78, 80, 82, 86 and related discussion in the specification).

Claims 11 and 25

The rejection of base claims 1 and 17 and intervening claims 10 and 24, respectively is incorporated. Fawcett further discloses *wherein determining one or more software upgrade releases further comprises: cross-referencing release-to-release product configurations for the software upgrade releases* (see at least Figure 4A, steps 72, 74, 76 and related discussion in the specification).

Claim 15

The rejection of base claim 14 is incorporated. Fawcett further discloses *wherein the supplier system comprises a software upgrade system having a software upgrade server connected to an interface server* (see at least Figure 2, items 40 and 46 respectively and related discussion in the specification).

Claim 16

The rejection of base claim 14 and intervening claim 15 is incorporated. Fawcett further discloses *wherein the supplier system further comprises a security mechanism connected to the software upgrade system, the security mechanism having connections to a network* (see at least 10:15-25).

Claim Rejections – 35 USC § 103

8. The following is a quotation of the 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in

the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 12, 13 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fawcett, as applied to base and intervening claims 1, 10 and 17, 24 respectively in view of U.S. Patent Application Publication No. U.S. 2002/0129356 to Hellerstein et al. ("Hellerstein").

Claims 12 and 26

The rejection of base claims 1 and 17 and intervening claims 10 and 24, respectively is incorporated. Fawcett does not specifically disclose *wherein determining one or more software upgrade releases further comprises: verifying pre-requisite and co-requisite software for the software upgrade releases*. However, Hellerstein discloses component dependency checking (see at least Figure 4 and related discussion in the specification) for the purpose of ensuring a trouble-free software upgrade automating. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to add Hellerstein's feature to Fawcett for the purpose discussed above.

Claim 13

The rejection of base claim 1 is incorporated. Fawcett does not specifically disclose *receiving an order for additional software; and verifying pre-requisite and co-requisite software for the additional software*. However, Hellerstein discloses component dependency checking (see at least Figure 4 and related discussion in the specification) for the purpose of ensuring a trouble-free software upgrade automating. It would have been

obvious to a person having ordinary skill in the art at the time the invention was made to add Hellerstein's feature to Fawcett for the purpose discussed above.

Conclusion

10. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoang-Vu "Antony" Nguyen-Ba whose telephone number is (571) 272-3701. The Examiner can normally be reached on Tuesday-Friday, 6:45 to 16:45.


If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Tuan Dam can be reached at (571) 272-3695. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR

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Should you have questions on access to the Private PAIR system, contact the
Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 **ANTHONY NGUYEN-BA**
PRIMARY EXAMINER

Art Unit 2122

January 17, 2005